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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dale Vonbehren

60287-USA

4525

7590

06/23/2009

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EXAMINER

SHEIKH, HUMERA N

ART UNIT

PAPER NUMBER

1615

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,317	Applicant(s) VONBEHREN ET AL.	
	Examiner Humera N. Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/08; 6/6/08; 9/17/08; 5/26/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1615

DETAILED ACTION

Status of the Application

Receipt of the Information Disclosure Statements (IDS) filed 5/5/08, 6/6/08, 9/17/08 and 5/26/09 is acknowledged.

Claims 1-18 are pending in this action. Claims 1-18 are rejected.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 5/5/08, 6/6/08, 9/17/08 and 5/26/09 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the Examiner.

* * * * *

Claim Objections

Claims 4-7, 9, 10 and 12-18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claims 1 and 4 are objected to because of the following informalities:

Claim 1 recites, "120 Pa s or less". The unit of measurement "Pa s" appears incomplete as it is currently written. Appropriate correction is required.

Claim 4 recites "comprises one of more agents". This limitation has a typographical error. The term "of" should instead be recited as "*or*" in order to permit the 'mixtures' of cosmetic agents. Appropriate correction is required.

Art Unit: 1615

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jose et al. (hereinafter "Jose") (U.S. Pat. No. 6,620,417).

Jose ('417) teaches a pigmented cosmetic composition containing organic oil and silicones, whereby the composition provides a long lasting durable finish on the skin and is comfortable to wear (see col. 1, lines 10-31 and Abstract). The cosmetic composition includes the use of: emulsifiers (25-50%) (col. 5, line 66 - col. 6, line 24); additives to enhance the performance of the composition - such as microcrystalline cellulose (rheology enhancer/control agent) in amounts of 1-50%, the microcrystalline cellulose having a particle size of 0.02 to 100 microns (col. 7, lines 23-54) (this particle size meets that of instant claims 1, 5 & 9); sunscreen agents (organic/inorganic) (1-50%) (col. 7, lines 23-54) (col. 9, lines 15-45); and humectants,

Art Unit: 1615

emollients, water, etc. (col. 10, lines 22-23). Additional agents disclosed include preservatives, antioxidants and vitamins (col. 9, line 47 – col. 10, line 11). The oils used in the composition are taught to have a viscosity of about 10 to 600,000 centipoise (equivalent to 0.10 Pas to 600 Pas). While the viscosity of the composition is not disclosed, it is the position of the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable viscosity ranges or levels through routine or manipulative experimentation, to obtain the best possible results, as these are variable parameters attainable within the art. Moreover, the viscosity of the individual oils falls within the ranges claimed by Applicant and thus would attribute to a suitable consistency for the cosmetic compositions.

The rundown time of 100 seconds or greater of instant claim 16 is met by the teachings of Jose. Jose teaches that their cosmetic composition provides a long lasting durable finish on the skin and is comfortable to wear and is transfer resistant (col. 1, lines 10-31).

Regarding the amounts/ranges, the Examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

With respect to the “method of applying a cosmetic by spraying the composition” of instant claim 18, it is the position of the Examiner that this limitation does not impart patentability to the claims. It is routine practice within the cosmetic art to have alternative methods of application for cosmetic products, such as by spraying, in order to offer convenience of use and application by the consumer.

Art Unit: 1615

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Jose. Jose explicitly teaches a pigmented cosmetic composition containing, among other skin additives, emulsifiers, rheology enhancers (i.e., microcrystalline cellulose), sunscreen agents, humectants, emollients, water, preservatives, antioxidants, etc. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

* * * * *

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pflücker et al. (hereinafter “Pflücker”) (U.S. Pat. No. 7,264,795).

Pflücker (‘795) teaches a sunscreen composition having UV protection properties and a high sun protection factor (see Abstract); (col. 5, lines 6-7). The sunscreen composition includes: organic sunscreen and inorganic sunscreen agents and presun and aftersun preparations (col. 2, lines 1-3; 64-67); (col. 4, lines 52-62) (col. 7, lines 25-28); emulsifiers (i.e., lecithin) (col. 6, lines 5-16); microcrystalline cellulose (rheology enhancer/control agent) (col. 6, line 65 – col. 7, line 4); moisturizers, surfactants, preservatives, pigments, dyes, thickeners, viscosity increasing agents and the like (col. 8, lines 20-61).

Examples of application forms of the cosmetic include sprays. Sprays can comprise customary propellants (col. 6, lines 35-56). Thus, the “method of applying a cosmetic by spraying the composition” of instant claim 18 is met by the teachings of the ‘795 Patent, since the compositions can be conveniently provided in the form of sprays.

Art Unit: 1615

It is taught that the performance of a cosmetic formulation according to the SPF is influenced by the distribution of the UV filters on the surface of the skin. Therefore the rheology of the formulation is a key issue to increase the SPF (boost effect) (col. 5, lines 12-16).

Regarding instant claims 6 and 7, the microcrystalline cellulose of the prior art (col. 7, line 2) would also be water-dispersible and co-processed absent a showing of evidence to the contrary.

Suitable amounts/ranges are identified in the Examples at columns 11-20 and the Tables at columns 19-34. Moreover, with regards to the instantly claimed percentages or amounts, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable ranges, percentages or ratios through routine or manipulative experimentation, to obtain the best possible results, as these are variable parameters attainable within the art. Furthermore, no unexpected or superior results have been observed in the instant amounts/ranges claimed. The prior art clearly teaches a formulation essentially the same as claimed based on the use of the same ingredients, as is claimed by Applicants.

With regards to the instant viscosity levels, suitable levels would be a result-effective parameter, obtained via routine experimentation by one of ordinary skill in the art. The reference

Art Unit: 1615

clearly teaches use of viscosity modifiers (col. 8, line 59) to yield an effective cosmetic composition.

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Pflücker. Pflücker explicitly teaches a sunscreen cosmetic composition containing, among other skin additives, emulsifiers, rheology enhancers (i.e., microcrystalline cellulose), sunscreen agents (organic/inorganic), moisturizers, surfactants, preservatives, pigments, dyes, thickeners, viscosity increasing agents and the like. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

* * * * *

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (hereinafter “Wang”) (U.S. Pat. No. 6,497,861) in view of GB 1,006,706 (FMC Corp.) (hereinafter “706 Patent”).

Wang (‘861) teaches a stable gelled cosmetic composition comprising emollients and emulsifiers (col. 5, lines 11-36); sunscreen actives, self-tanning agents and anti-dry skin agents (col. 6, line 62 – col. 7, line 25); surfactants, fragrances, preservatives and the like (col. 7, lines 40-50). The composition can be in various forms and is long-wearing (col. 7, lines 27-39).

With respect to the “method of applying a cosmetic by spraying the composition” of instant claim 18, it is the position of the Examiner that this limitation does not impart patentability to the claims. It is routine practice within the cosmetic art to have alternative

Art Unit: 1615

methods of application for cosmetic products, such as by spraying, in order to offer convenience of use and application by the consumer.

Suitable amounts/ranges are identified in the Examples at columns 7-9. Moreover, with regards to the instantly claimed percentages or amounts, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable ranges, percentages or ratios through routine or manipulative experimentation, to obtain the best possible results, as these are variable parameters attainable within the art. Furthermore, no unexpected or superior results have been observed in the instant amounts/ranges claimed. The prior art clearly teaches a formulation essentially the same as claimed based on the use of the same ingredients, as is claimed by Applicants.

With regards to the instant viscosity levels, suitable levels would be a result-effective parameter, obtained via routine experimentation by one of ordinary skill in the art.

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Wang. Wang explicitly teaches a cosmetic composition containing, among other skin additives, emulsifiers, sunscreen agents, moisturizers, surfactants, preservatives, pigments, colorants, and the like. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

Art Unit: 1615

While Wang does not explicitly teach rheology enhancers, such as microcrystalline cellulose, the use of microcrystalline cellulose in the cosmetic art is well known to one of ordinary skill in this art. Such skill is evident from the '706 Patent (see below).

The **'706 Patent** (FMC Corp.) teaches a cosmetic composition containing cellulose crystallite aggregates, product obtained by the acid hydrolysis of cellulose. Cosmetic compositions disclosed include sunscreens, depilatories and the like (col. 1, lines 10-42). '706 teaches the crystallite aggregates are one of the purest forms of cellulose and are not likely to cause undesirable dermatological reactions (col. 2, lines 61-67). The cellulose crystallite aggregates have a particle size from below 1 micron to 300 microns (col. 2, lines 67-73). It is taught that by virtue of their unique properties, the crystallite aggregates are capable of improving a wide range of cosmetic products. In particular, the aggregates possess the highly useful property of forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates permits production of stable gels and dispersions without requiring presence of other ingredients (i.e., emulsifiers).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the cellulose crystallite aggregates having a particle size from below 1 micron to 300 microns, as taught by the '706 Patent within the cosmetic compositions of Wang. One would do so with a reasonable expectation of success because '706 teaches that crystallite aggregates possess unique properties and are capable of improving a wide range of cosmetic products. The aggregates are especially useful in forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates

Art Unit: 1615

permits production of stable gels and dispersions without requiring the presence of other ingredients. The expected result would be an improved cosmetic composition that exhibits enhanced tactile and aesthetic properties.

* * * * *

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al. (hereinafter “Tanner”) (U.S. Pat. No. 5,935,556) in view of GB 1,006,706 (FMC Corp.) (hereinafter “706 Patent”).

Tanner (‘556) teaches sunscreen compositions that include: sunscreen actives (UV absorbers, etc.) and emulsifiers in amounts of about 0.1% - about 10% (col. 2, lines 50-57); (col. 3, lines 42-49); (col. 5, line 57 - col. 6, line 21); skin care actives such as humectants, occlusive agents, moisturizers, tanning agents, thickening agents, preservatives and the like (col. 6, line 43 – col. 7, line 29) and water (from about 20-98%) (col. 5, lines 25-28) (this range reads on and encompasses the “about 55 wt% - about 80 wt%” of instant claim 17).

The emulsions provide a viscosity of from about 1 cps to about 1,000,000 cps (equivalent to 0.001 Pas to 1,000 Pas) (col. 3, lines 50-63). This viscosity reads on the viscosity claimed by Applicant (of 120 Pas or less and 80 Pas or less of instant claims 1 and 15, respectively).

Examples of application forms of the cosmetic include sprays and spray-on-products. Sprays can comprise customary propellants (col. 6, lines 22-43). Thus, the “method of applying a cosmetic by spraying the composition” of instant claim 18 is met by the teachings of the ‘556 Patent, since the compositions can be conveniently provided in the form of sprays. Moreover, it is routine practice within the cosmetic art to have alternative methods of application for cosmetic

Art Unit: 1615

products, such as by spraying, in order to offer convenience of use and application by the consumer.

The reference recognizes and teaches suitable amounts/ranges as identified in the disclosure. Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Tanner who explicitly teaches a cosmetic sunscreen composition containing, among other skin additives, emulsifiers, sunscreen agents moisturizers, surfactants, humectants, artificial tanners and the like. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

While Tanner does not explicitly teach rheology enhancers, such as microcrystalline cellulose, the use of microcrystalline cellulose in the cosmetic art is well known to one of ordinary skill in this art. Such skill is evident from the '706 Patent (see below).

The **'706 Patent** (FMC Corp.) teaches a cosmetic composition containing cellulose crystallite aggregates, product obtained by the acid hydrolysis of cellulose. Cosmetic compositions disclosed include sunscreens, depilatories and the like (col. 1, lines 10-42). '706 teaches the crystallite aggregates are one of the purest forms of cellulose and are not likely to

Art Unit: 1615

cause undesirable dermatological reactions (col. 2, lines 61-67). The cellulose crystallite aggregates have a particle size from below 1 micron to 300 microns (col. 2, lines 67-73). It is taught that by virtue of their unique properties, the crystallite aggregates are capable of improving a wide range of cosmetic products. In particular, the aggregates possess the highly useful property of forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates permits production of stable gels and dispersions without requiring presence of other ingredients (i.e., emulsifiers).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the cellulose crystallite aggregates having a particle size from below 1 micron to 300 microns, as taught by the '706 Patent within the cosmetic compositions of Tanner. One would do so with a reasonable expectation of success because '706 teaches that crystallite aggregates possess unique properties and are capable of improving a wide range of cosmetic products. The aggregates are especially useful in forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates permits production of stable gels and dispersions without requiring the presence of other ingredients. The expected result would be an improved cosmetic composition that exhibits enhanced tactile and aesthetic properties.

* * * * *

Conclusion

- No claims are allowed at this time.

Art Unit: 1615

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday-Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Humera N. Sheikh/

Primary Examiner, Art Unit 1615

hns

June 22, 2009

Application/Control Number: 10/528,317

Page 14

Art Unit: 1615